

## **REMARKS/ARGUMENTS**

The foregoing amendments in the claims are fully supported by the specification and claims as originally filed, and do not add new matter.

With this amendment, Claims 28-35 and 38-40 have been amended in order to further clarify what Applicants have always regarded as their invention.

Claims 28-35, 38-40 and 44-47 are pending in this application.

### **I. Claim Rejections Under 35 U.S.C. §102**

Claims 28-35, 44 and 46 are rejected under 35 U.S.C. §102(a) as allegedly being anticipated by Yousef *et al.* The Examiner asserts that "The claimed invention is drawn to an isolated nucleic acid which encodes a polypeptide having 100% sequence identity to SEQ ID NO:194. Yousef *et al.* does teach that nucleic acid, as shown by their teaching of Reversed contig 37, which is an 80 Kb genomic DNA which comprises an open reading frame, "KLK-L5" which is shown (in the sequence comparison) to consist of a polypeptide that is 100% identical to SEQ ID NO:194." (Page 2 of the Advisory Action mailed June 9, 2005).

Without acquiescing to the propriety of the Patent Office's rejection, Applicants note that the claims, as amended herein, recite isolated cDNAs encoding SEQ ID NO:194 or polypeptides having at least 80% sequence identity to SEQ ID NO:194. This amendment was suggested by the Examiner, in a telephone conversation on July 29, 2005, as acceptable to distinguish the instant invention from the sequence disclosed by Yousef *et al.*

The Examiner has acknowledged that "Yousef *et al.* only identify some of the exons encoded by the genomic DNA which are a part of KLK-L5." (Page 2 of the Office Action mailed March 31, 2005). Thus Yousef *et al.* do not teach a cDNA which encodes SEQ ID NO:194. Nor does Yousef *et al.* disclose cDNAs that encode polypeptides having at least 80% amino acid sequence identity to SEQ ID NO:194.

Applicants respectfully submit that a rejection under 35 U.S.C. § 102 can only be proper if the cited reference recites every element of the rejected claim. "For a prior art reference to anticipate in terms of 35 U.S.C. §102, every element of the claimed invention must be shown in a

single reference." See *In re Bond*, 910 F.2d 831, 15 USPQ2d 1566 (Fed. Cir. 1990). M.P.E.P. §2131 further provides, "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described in a single prior art reference.' *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). 'The identical invention must be shown in as complete detail as contained in the ... claim.' *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989)." Yousef *et al.* do not disclose a cDNA that encodes the polypeptide of SEQ ID NO:194 as recited in the claims. Nor does Yousef *et al.* disclose cDNAs that encode polypeptides having at least 80% amino acid sequence identity to SEQ ID NO:194.

Accordingly, Yousef *et al.* does not anticipate the claimed nucleic acids, and the withdrawal of the rejection of Claims 28-35, 44 and 46 under 35 U.S.C. §102(a) is therefore respectfully requested.

## CONCLUSION

All claims pending in the present application are believed to be in *prima facie* condition for allowance, and an early action to that effect is respectfully solicited.

Please charge any additional fees, including any fees for additional extension of time, or credit overpayment to Deposit Account No. 08-1641, referencing Attorney's Docket No. 39780-2830 P1C51). Please direct any calls in connection with this application to the undersigned at the number provided below.

Respectfully submitted,

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